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7590 Stephen B. Salaf Harter, Secrest and Emory LLC 1600 Bausch & Lomb Plaza Rochester, NY 14604			EXAMINER POPHAM, JEFFREY D	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MENNO ANNE TREFFERS and
ANTONIUS ANDRIAAN MARIA STARING

Appeal 2007-3722
Application 09/930,654
Technology Center 2100

Decided: May 19, 2008

Before JAMES D. THOMAS, LANCE LEONARD BARRY,
and STEPHEN C. SIU, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 13. We have jurisdiction under 35 U.S.C. § 6(b).

As best representative of the disclosed and claimed invention, independent claim 1 is reproduced below:

1. A method for controlling distribution and use of a digital work (DW), comprising the steps of:

(a) attaching a usage right information to said digital work (DW), said usage write information defining one or more conditions which must be satisfied in order for said usage right to be exercised;

(b) storing said digital work (DW) and its attached usage right information on a record carrier (10);

(c) updating said attached usage right information with every use of said digital work (DW); and

(d) refusing the use of said digital work if said usage right information indicates that the usage right has been exercised; characterized in that

(e) a hidden information (KLK) stored in a hidden channel and used for encrypting or verifying said usage right information is changed when said usage right information has changed.

The following references are relied on by the Examiner:

Ginter	US 5,892,900	Apr. 6, 1999
Smithies	US 6,064,751	May 16, 2000
Downs	US 6,226,618 B1	May 1, 2001 (filing date Aug. 13, 1998)
Shear	US 2001/0042043 A1	Nov. 15, 2001 (filing date May 15, 1997)

Claims 1 through 13 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Shear in view of Downs, further in view of Ginter as to claims 1 and 3 through 13, with the addition of Smithies as to claim 2 in a second stated rejection.

Rather than repeat verbatim the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for Appellants' positions and to the Answer for the Examiner's positions.

OPINION

For the reasons set forth by the Examiner in the Answer, as expanded upon here, we sustain the two stated rejections under 35 U.S.C. § 103 encompassing claims 1 through 13 on appeal. According to the remarks set forth at the bottom of page 5 and the bottom of page 11 of the principal Brief on appeal, Appellants group independent claims 1 and 13 together while, at the same time, presenting additional arguments as to independent claim 11 at page 12 of the principal Brief. We treat the separate positions with respect to dependent claims 2 through 4, 8, and 12.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S. Ct. at 1739. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. The Court noted that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 1742.

The Federal Circuit recently concluded that it would have been obvious to combine (1) a device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) a processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). In reaching that conclusion, the Federal Circuit recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *Id.* at 1161 (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

Regarding the positions in the Brief and Reply Brief as to the alleged lack of motivation to combine Shear in view of Downs and Ginter, the above noted case law presents a less restrictive analytical frame work to properly consider the combinability of the respective teachings of these references within 35 U.S.C. § 103. The Examiner's rationales in the Answer in the statement of the rejection as well as the responsive arguments appear to us to meet the requirements set forth according to this case law.

Moreover, Appellants recitations of independent claims 1, 11, and 13 take the form of utilizing a "characterized in" clause for each of these independent claims which, according to our understanding of conventional practice in Europe, presents a Jepson-type claim format. In an event, it is stated in the originally filed version of the Specification at page 2, lines 1 through 19 that the preambles of independent claims 1 and 13, for example, are admitted to be known in the prior art according to a prior US patent. Appellants characterized their contributions in the art at originally filed Specification page 4, lines 3 through 4 consistent with the recitation in the characterized clause as noted with respective independent claim 1 reproduced earlier. In fact, Appellants' arguments in the principal Brief and the better stated version of them in the Reply Brief repeatedly focus only upon the recitations in this characterized in clause.

To address briefly, from our perspective, the combinability issue, we note that each of the three primary references relied upon in the first stated rejection all contain teachings relating to the secure delivery and rights management of digital assets communicated over a global communication network. Additionally, to the extent the Examiner asserts at page 11 of the

Answer that Ginter is discussed within Shear and the corresponding opposing view at page 8 of the Reply Brief that Shear does not specifically indicate what Ginter document is referred to, we note that Ginter's contributions in the art are referred to in different locations in Shear. These include the discussions at page 3, paragraphs 0036 and 0040, as well as the discussions at page 23, paragraph 0332 in the context of the Virtual Distribution Environment (VDE). The Ginter patent relied upon by the Examiner discusses such VDE environments beginning in the abstract of his disclosure. Moreover, Shear's page 24, paragraph 0351, through page 25, paragraph 0361, discussions are in the same vein as they relate to Shear's figures 15A-C. It is also noted that both the Ginter patent and the Shear published application are assigned to the same assignee. All these considerations weigh heavily towards concluding that the combinability of the respective teachings of these references is proper within 35 U.S.C. § 103 in addition to the reasoning set forth by the Examiner in the Answer.

With respect to notable teachings in Shear the corresponding showings in figures 3 and 5 are significant. Note the discussions at pages 4 and 9 of the Answer relating to pages 15 through 18 and various paragraphs noted by the Examiner that relate to the figure 3 showings in this reference, which depicts on a digital video disk 100 hidden keys 210, as well as encrypted keys 208, as well as a secure software container 206, which has within it a content set 204. It is the discussion of these hidden keys 210 and the encrypted keys 208 in figure 3 and the Examiner-relied upon paragraphs 0216 and 0218 at page 15 of Shear that relate to the usability of them for usage right indications or permission capabilities. The discussion at page 17

of Shear from paragraphs 0250 through 0254 relied upon by the Examiner indicates at least in paragraph 0250 that the hidden keys 210 are fetched from the disk 100 and are use to decrypt some or all of the other encrypted key blocks 208. We agree with the Examiner's basic view that the hidden information and hidden channels of independent claims on appeal relate to these concepts.

Other significant teachings relate to the independent claims, and particularly the negative limitation of independent claim 11 of the hidden channel "not accessible by commercial reproducing devices." This feature, not present in independent claims 1 and 13 on appeal, is also taught. Figure 4A in Shear indicates in box 404 that the drive for playing this video disk 100 in figure 3 stores keys without exposing them to the player. Corresponding teachings are found at page 15, paragraph 0218 and page 17, paragraph 0250.

Of significant importance to the arguments presented in the Brief and Reply Brief relating to the updating and changing requirements of the hidden information stored in the hidden channel of the claims on appeal is the teaching at page 10, paragraph 0134 in Shear. This paragraph indicates that not only can the keys for encryption and decryption purposes in the reference be added to or deleted from the player, the capability exists for adding new or additional keys that are automatically loaded by playing certain types DVDs. This paragraph also indicates the deletion and/or revocation of keys which meet the destruction requirements of dependent claim 4.

The significance of these teachings in this paragraph in Shear also directly relates to the Examiner's noted teachings at column 136, lines 37 through 42, of Ginter which explicitly indicates that one or more keys used to encrypt each permission record or other management information record may be changed every time the record is updated or upon the occurrence of other events such as to permit the updated record to be re-encrypted with new or more keys. Not only do these teachings relate to the encryption capability of the characterized in clause that are strongly argued in the Reply Brief not to be taught among the references, the changeability and/or updatability of the keys is expressly taught in both references. While Shear's environment of usage of the changeability of the keys applies to all usages of the keys, the teaching just noted in Ginter relates to the requirement that the keys are updated for encryption purposes when usage rights information has changed.

As correctly noted by the Examiner at the bottom of page 9 of the Answer, the requirements of this characterized in clause relating to the changeability of the hidden information indicates that its use is broadly stated to occur in the alternative, that is, for encrypting or otherwise verifying usage rights information. Not only do Ginter's teachings indicate the changeable keys may be used for encrypting purposes related to use, the more broadly recited capability of the use of changing the keys for verifying the usage rights information is also more broadly taught in context.

Therefore, when the more focused arguments in the Reply Brief are considered urging patentability of the applied prior art, we strongly agree with the Examiner's view that not only are the references properly

combinable within the 35 U.S.C. § 103 in the first stated rejection, the argued features relating to the characterized in clause are taught as well.

We turn now to the positions with respect to dependent claims 3 and 4, which are argued together at pages 12 and 13 of the principal Brief on appeal. The Examiner has addressed these concerns with respect to the teachings of Ginter beginning at the bottom of page 11 of the Answer. These are not challenged in the Reply Brief. The separate positions with respect to dependent claims 8 and 12 as presented at pages 13 and 14 of the principal Brief on appeal effectively argue patentability based upon the distinctions alleged with respect to independent claims 1 and/or 11 respectively. In a corresponding manner, with respect to the second stated rejection of dependent claim 2, Appellants' remarks at the bottom of page 14 of the principal Brief acknowledge what the Examiner relies upon in Smithies and do not separately contest the proper combinability of this reference with the teachings already relied upon as to Shear, Downs, and Ginter. Again, the arguments urging patentability are based upon the arguments presented with respect to independent claim 1 in the first stated rejection. Since no arguments are presented as to any other dependent claim on appeal, any arguments that could have been made with respect to them are waived.

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 13 under 35 U.S.C. § 103 is affirmed since Appellants have not presented any persuasive arguments of error as to the Examiner's reliance and reasoning of unpatentability of these claims.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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